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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,303	02/27/2004	Takashi Tomiyama	03500.017919.	4362
5514 7590 02/17/2009 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
BUTLER, PATRICK NEAL				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/787,303

Applicant(s)

TOMIYAMA ET AL.

Examiner

Patrick Butler

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki et al (U.S. Patent 4,825,249) in view of Ferrigno (US Patent No. 3,024,209) and Cahill et al (U.S. Patent 3,387,071).

Oki discloses a process for producing a cleaning blade reading on claim 1. Oki teaches providing a urethane cleaning blade for use with a photoelectronic copying machine and coating it with a mixture that includes an isocyanate compound to deliver wear resistance and lubricating properties (see col. 1, lines 60-68 and col. 3, lines 58-63). Oki further teaches that the isocyanate compound is caused to react (cure) on the surface of the urethane substrate with unreacted elements thereon (see col. 2, lines 31-46). Oki teaches that the coating is applied by dipping (impregnating, immersing), as required by claims 1 and 3 (see col. 3, lines 38-43). Oki's treatment causes the surface layer to form allophanate bonds to the extent that only some of the layer is left unreacted (formed chiefly of allophanate linkages) (see col. 2, lines 15-23).

Oki does not disclose having water in the blade being treated but also does not appear to expressly teach that the urethane has a water content of 1% by weight or less.

Ferrigno teaches that additives of a reaction with urethane and isocyanate should be free of moisture, or less than about 1% free moisture, due to its reacting with the isocyanate (see col. 5, lines 51-57). Moisture was avoided via drying (see col. 9, lines 39-46). When these two aspects are considered together, Ferrigno's teaching is therefore to dry the agents in a reaction system of isocyanate and urethane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ferrigno's teaching of drying to prevent moisture in a reaction system of isocyanate and urethane with Oki's method of reacting urethane and isocyanate in order to minimize isocyanate unable to react with the urethane.

Oki does not teach removing excess compound with warm or hot air having a temperature sufficient to render the compound flowable, as required by claim 1. Oki further does not teach removing excess isocyanate compound with a solvent, as required by claim 2.

Cahill et al, hereafter "Cahill", teaches forming a urethane object, in this case a fiber, by using an excess of an isocyanate compound and removing this excess with hot air in reference claims 4 and 5. Herein Cahill refers to excess extender, making reference to the reaction functionality of the isocyanate. Using a temperature above the melting point of the isocyanate compound, thereby maintaining flowability for the purpose of sheeting the fluid, would have been obvious as a matter of choice to one skilled in the art. Also, it would have been obvious as a matter of choice for one skilled in the art to follow up the hot air doctoring with a solvent to insure the complete removal of isocyanate from the surface.

Oki and Cahill are combinable because they are concerned with a similar technical field, namely, urethane compositions. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Oki the isocyanate removal process, as taught by Cahill. The motivation to do so would have been to prevent deterioration of lubricating properties by any unreacted end reactive groups remaining. See lines 53-55 in column 3 of Oki.

Response to Arguments

Applicant's arguments filed 18 November 2008 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 USC §103(a) rejections. Applicant's arguments appear to be on the grounds that:

- 1) Oki does not expressly teach that the cured layer is formed chiefly of allophanate linkages, and Ferrigno also does not teach the limitation.
- 2) The claimed limitation of having 1% by weight or less water in the urethane resin is not met since Ferrigno's 1% limitation does not pertain to urethane. Instead, it pertains to a different process.

The Applicant's arguments are addressed as follows:

- 1) With respect to the newly claimed limitation of "formed chiefly of allophanate linkages," as recited above, Oki's treatment causes the surface layer to form allophanate bonds to the extent that only some of the layer is left unreacted (formed chiefly of allophanate linkages) (see col. 2, lines 15-23).

1) Moreover, the claimed process result of "formed chiefly of allophanate linkages" is taught by the applied references principally because they teach the claimed steps.

2) As recited above, Ferrigno's teaching that additives of a reaction with urethane and isocyanate should be free of moisture, or less than about 1% free moisture, due to its reacting with the isocyanate (see col. 5, lines 51-57). Moisture was avoided via drying (see col. 9, lines 39-46). When these two aspects are considered together, Ferrigno's teaching is therefore to dry the agents in a reaction system of isocyanate and urethane. Thus, as recited above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ferrigno's teaching of drying to prevent moisture in a reaction system of isocyanate and urethane with Oki's method of reacting urethane and isocyanate in order to minimize isocyanate unable to react with the urethane.

2) Moreover, in response to applicant's argument that Ferrigno's water content of prepolymer does not teach the water content of urethane blades, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

2) Moreover, the criticality of water content being less than 1% was necessarily taught by Ferrigno's teaching of having isocyanate reaction components free of moisture or less than about 1% free moisture (see col. 5, lines 51-57).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./
Examiner, Art Unit 1791

/Christina Johnson/
Supervisory Patent Examiner, Art Unit 1791